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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,693	06/13/2006	Pierre-Yves Coqueron	P/3610-69	9099

2352 7590 07/27/2007
OSTROLENK FABER GERB & SOFFEN
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NEW YORK, NY 100368403

EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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07/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/582,693

Applicant(s)

COQUERON ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/13/06</u> | 6) <input type="checkbox"/> Other: ____ |

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Detailed Action

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 16, 19, 20 rejected under 35 U.S.C. 102(b) as being anticipated by Cooke et. al.

Cooke et. al., discloses compounds 302, 310, 313, 319, 325, 326 and 340, instant compositions containing them, and an instant method of combating fungal pests such as phytopathogenic fungi with the compounds. At column 22, in Table D and at column 23, Table D, see the instant compounds, at column 6, lines 18-27, see the instant compositions, and at column 5, lines 25-30, see the instant method.

At Table D, column 22, and at columns 23 and 24 in Table D, see the instant compounds.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 16, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et. al.

Cooke et. al. teaches compounds, 301-309, 315, 321, 323, 324, 328-331, 334, 335, 337-339, compositions containing them, and a method of combating fungal pests

such as phytopathogenic fungi with the compounds. At column 22, in Table D and at column 23, Table D, see the compounds, at column 6, lines 18-27, see the compositions, and at column 5, lines 25-30, see the prior art method.

The difference between the Cooke et. al. compounds and the instantly claimed compounds is the position of the Rb group on the phenyl ring. The prior art compounds contain a Rb group at a position other than the 2 position and these compounds are positional isomers of the instant compounds. **Structural isomerism (or constitutional isomerism)** is a form of isomerism in which molecules with the same molecular formula have atoms bonded together in different orders, as opposed to stereoisomerism. In positional isomerism, a functional group changes position on the chain. The prior art compounds are positional isomers of the instant compounds.

It would have been obvious to one of ordinary skill in the art to modify the prior art compounds which are useful as phytopathogenic fungicides to obtain positional isomers. Accordingly, the compounds, compositions, and methods of treating, are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the prior art compounds, compositions, and methods of treating.

Claims 1-12, 14-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moloney et. al.

Moloney et. al. teaches compounds, 1, 3-4, 7-9, 12-23, 25-35, 37, 40, 42, 44-58, 61, 63-64, 66-71, 73-87, 90-104, 107, 109-114, 116-120, 126-143, 145-152, 154-155, 157-176, 178, 180-182, 184-194, 201, compositions containing them, and a method of combating fungal pests such as phytopathogenic fungi with the compounds. At Table 1,

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See the compounds and at page 4, lines 21-22, see where it states that these compounds have activity as fungicides. See page 5, lines 4-5 where compositions are taught.

The difference between the Moloney et. al. compounds and the instantly claimed compounds is the alkylene group between the pyridinyl group and the amide moiety of the compound. In the prior art compounds, the alkylene group is a substituted or unsubstituted methylene group. In the instant compounds, the alkylene group is a substituted ethylene group. The prior art compound and the instant compound are homologues of each other. Homologues are compounds that differ by a methylene linkage.

It would have been obvious to one of ordinary skill in the art to modify the prior art compounds which are useful as phytopathogenic fungicides. Accordingly, the compounds, compositions and method of treating are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the prior art compounds.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using the compounds of formula I with X equal to hydrogen or CF₃, R₁ and R₂ equal to H or C₁-C₆ alkyl, or benzyl, or R₃ and R₄ equal to a hydrogen atom or a carbamoyl

group or C1-C6 alkyl, or phenyl, and R5 equal to hydrogen or C3-C7 cycloalkyl, or Y equal to hydrogen or a halogen or C1-C8 alkyl, or C1-C8 alkoxy, or Rb equal to C1-C6 alkyl, or C1-C6 halogenoalkyl having 1 to 5 halogen atoms or C1-C6 alkoxy, or C1-C6 alkylamino, does not reasonably provide enablement for using the compounds with X, R1, R2, R3, R4, R5, Y, equal to all other moieties claimed. The specification does not enable any skilled artisan to use the invention commensurate in scope with these claims.

a) Determining if any particular claimed compounds with X, R1, R2, R3, R4, R5, Y, equal to all other moieties that are not enabled as described above would be active would require synthesis of the substrate and subjecting it to testing with Applicants' in vivo biological assays on various fungi as detailed at pages 51-54. Considering the large number of compounds to be made this is a large quantity of experimentation. b) The direction concerning the claimed compounds is found at pages 33-54, which merely states Applicants' intent to make and use such compounds. c) In the instant case none of the working examples contains any radical with X, R1, R2, R3, R4, R5, Y, equal to moieties other than those stated to be enabled above.

d) The nature of the invention is preventatively or curatively combating the phytopathogenic fungi of crops with the instant compounds.

e) There is no reasonable basis for the assumption that the myriad of compounds embraced by the present formula (I) will all share the same chemical and biological properties. h) The breadth of the claims includes all of millions of compounds of formula (I). Thus, the scope is very broad. The present claims embrace various heterocyclic radicals, which are not art-recognized as equivalent. The specific compounds made are not adequately representative of the compounds embraced by the extensive Markush groups instantly claimed.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to practice Applicants' invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Janet Andres can be reached on 571-272-0867.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.



BMR
July 18, 2007



JANET L. ANDRES
SUPERVISORY PATENT EXAMINER